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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,990	03/16/2004	Donald L. Clason	3270	3925
26645 7590 03/04/2009 THE LUBRIZOL CORPORATION ATTN: DOCKET CLERK, PATENT DEPT. 29400 LAKELAND BLVD. WICKLIFFE, OH 44092				
EXAMINER				
GOLOBY, JAMES C				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
03/04/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/802,990

**Applicant(s)**

CLASON, DONALD L.

**Examiner**

James Goloboy

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18, 19, 21-34 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-19, 21-34, 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Applicant's amendments filed 11/24/08 fail to overcome the rejections set forth in the office action mailed 6/12/08, which are maintained below. Newly added claim 36 is also rejected below.

***Claim Rejections - 35 USC § 103***

2. Claims 18-19, 21-28, 30-31, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeSuer in view of Stewart.

The discussion of LeSuer and Stewart in paragraph 2 of the office action mailed 4/13/07 is incorporated here by reference. Amended claim 18 and newly added claim 36 now recite concentrations of dispersant and dithiophosphate. LeSuer discloses in column 13 lines 39-42 that the dispersant is used in a lubricating composition in an amount of 0.5 to 10% by weight, overlapping the ranges recited in claim 18 and 36. In composition D (columns 15-16), LeSuer discloses a composition containing 0.07% by weight of phosphorus as zinc dioctyl dithiophosphate. Zinc dioctyl dithiophosphate has a molecular weight of 772.47, and contains 8% by weight of phosphorus. The composition of LeSuer therefore contains about 0.88% by weight of dithiophosphate, within the ranges recited in the amended claims. The other compositions of LeSuer contain similar concentrations of dithiophosphate. LeSuer and Stewart therefore meet the limitations of the amended claims.

3. Claims 18-19, 21-31, and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeSuer in view of Stewart as applied to claims 18-19, 21-28, and 30-31 above, and further in view of Emert.

The discussions of LeSuer in view of Stewart in previous office actions and paragraph 2 above and LeSuer in view of Stewart and Emert in paragraph 3 of the office action mailed 4/13/07 are incorporated here by reference. The use of the additive and concentrations of Emert in the composition of LeSuer and Stewart meets the limitations of claims 18-19, 21-31, and 33-36.

4. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over LeSuer in view of Stewart as applied to claims 18-19, 21-28, 30-31, and 36 above, and further in view of Byford.

The discussions of LeSuer in view of Stewart in previous office actions and paragraph 2 above and LeSuer in view of Stewart and Byford in paragraph 4 of the office action mailed 4/13/07 are incorporated here by reference. It would have been obvious to one of ordinary skill in the art to use of the substituted benzotriazoles of Byford as the metal deactivator in the lubricating method of LeSuer and Stewart, in order to prevent corrosion of metal surfaces, as taught in column 2 lines 15-22 of Byford.

***Response to Arguments***

5. Applicant's arguments filed have been considered but are not persuasive.

Applicant argues that the claims have been amended so that the results reported in the specification and declaration are commensurate in scope with the claims. However, while the claims have been amended to limit the concentrations of dispersant and dithiophosphate, the ranges are still significantly broader than the compositions for which the alleged unexpected results are demonstrated. All the inventive compositions contain about 1% by weight of the dithiophosphate, while the claimed compositions can contain as little as 0.2% (claim 18) or 0.4% (claim 36) by weight of dithiophosphate. Similarly, the claimed compositions can contain up to 4% by weight of dithiophosphate, and there is no indication that the inventive compositions give superior results to the comparative compositions at this concentration. The concentrations of dispersant are similarly incommensurate in scope with the claims, and the claimed dispersants can be the reaction product of any polyalkenyl-substituted acylating agent with any polyol.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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